

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named
Inventor: Maclean et al.

Appln. No.: 10/664,236

Group Art Unit: 3761

Filed: September 17, 2003

Examiner: Anderson, Catharine L.

Title: Miscarriage Care Package

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program at OG Notices: 12 July 2005, and further pursuant to the extension of that program at OG Notices: 07 February 2006, applicants request review of the final rejection in the above-identified application for the reasons stated below.

Applicants initially filed a full appeal to the Board of Patent Appeals and Interferences in reply to a final office action mailed on 09/17/2008. In response, the Examiner re-opened prosecution and issued a Final Office action mailed 09/29/2009 ("Office Action") in which the Examiner withdrew her earlier 35 U.S.C. 102 rejections and her 35 U.S.C. 103(a) rejections with respect to Schumacher (U.S. Patent 4,917,238) standing alone, and instead substituted a rejection of claims 1, 25 – 31 under 35 U.S.C. 103(a) as unpatentable over Schumacher in view of Friedbauer (US Publication 2001/0032712). Nevertheless, the substance of the Examiner's rejections remains the same as the previous office action. As such, Applicants hereby direct the attention of the Board to the full Appeal Brief filed on 17 April 2009 ("Appeal Brief") which is still on point, and specifically to selected sections as detailed below.

Rejection of Claims 1, 25 – 31, 35 – 37 and 40 under 35 U.S.C. §112, first paragraph.

The Examiner states that the "under pad/bed liner ... having a bottom layer and a top layer ... the top layer is designed to absorb bodily fluids, and wherein the bottom layer protects

the surface from bodily fluids that soak through the top layer,” as recited in independent claims 1 and 35, and “the miscarriage kit of claim 1, wherein the bottom layer of the under pad/bed liner is impermeable to bodily fluids,” as recited by claim 40, are not supported by the specification.

In the Appeal Brief, Applicants cited several sections of the specification that support the claimed language. Specifically, Applicants cited discussion of a bedding liner with a polypropylene backing as support that the bottom layer protects the surface from spilled bodily fluids and is impermeable to bodily fluids, *See Appeal Brief*, page 14 – 16. Because polypropylene is capable of both permeable and non-permeable configurations, Applicants’ position is that, at least, disclosure of polypropylene (capable of being both permeable and non-permeable) is sufficient disclosure to support a specific polypropylene configuration. Further, when taken in context of the entire specification as a whole, such disclosure provides support for the bottom layer having either a protective function or the bottom layer being impermeable to fluids. The Examiner’s position seems to be that because polypropylene can have two states, permeable or non-permeable, that Applicant has not enabled *either* permutation. The Examiner has stated no authority or reasoning for that proposition, nor has she established that one skilled in the art would not consider *both* permutations to be described and in possession of the applicants as she must under MPEP §2163(II)(A)(3)(b), and specifically with respect to the protective functions described in the specification. This argument is fully developed in Applicant’s appeal brief at least on pages 14 – 16.

Finally, claims 1 and 35 merely recite a layer that protects from “bodily fluids that soak through the top layer.” Even a permeable polypropylene will provide a layer of protection in the sense that it will separate a perhaps saturated top layer from touching the bedding and/or seating surface it is placed upon. Preventing the top layer from touching the bedding will reduce the bedding and/or furniture from *wicking moisture from the top layer*. Thus while a permeable bottom layer will not prevent liquids dripping from the top layer from being absorbed by the surface, it will prevent a wicking effect. Accordingly, reconsideration and withdrawal of the 35 USC 112 rejection is requested.

Claims 1 and 25 – 31 are not obvious in view of Schumacher and Friedbauer

The Examiner’s last Office Action, with respect to the §103 rejections merely repeats the arguments she has made the past several Office Actions with the exception of an additional

reference to Friedbauer, which she claims discloses a multiple layer paper towel. *See Office Action of 9/29/2009.*

As discussed in the Appeal Brief, the Examiner's §103 rejection is not appropriate. The reasons asserted in the Appeal Brief for supporting the Applicants' position are incorporated herein in their entirety. Appeal Brief, pages 24 – 32. Specifically, the Examiner has failed to explain how Schumacher (and now Friedbauer) is pertinent prior art. Also, the Examiner's insistence that certain features of Schumacher are equivalent to certain features of the present invention constitutes clear error.

First, the Examiner has never ascertained or explained, despite requests for such *See Office Action Reply dated 6/17/08, Appeal Brief*, why one skilled in the art would find Schumacher to be pertinent prior art. With respect to Schumacher, the Applicants have argued and maintain the argument, specifically pages 26 – 27 of the Appeal Brief, that Schumacher is not pertinent prior art. Specifically, the fields of endeavor are different, and the problems in the fields of endeavor are different. *See Appeal Brief, pages 26 – 27.* This glaring deficiency is repeated with respect to Friedbauer. Friedbauer is a patent application for a “method of imparting ... visual aesthetics to a tissue ...” *Friedbauer*, Abstract. Applicants can discern no manner in which such visual aesthetics are pertinent to the problem of caring for a woman experiencing a miscarriage. As such, one skilled in the art would not look to Schumacher or Friedbauer to construct a miscarriage care kit.

Even assuming that Schumacher *is* pertinent prior art (which the Applicants assert it is not), Schumacher alone, or in view of Friedbauer does not render the invention of claims 1, 25-31 obvious. Applicants' arguments with respect to Schumacher are set forth in the Appeal Brief at least at pages 28 – 32. In summary, the Examiner fails to consider both the references as a whole, fails to consider the specification and claims of the current invention as a whole, improperly characterizes Schumacher, and fails to consider independent proof of non-obviousness. *See Appeal Brief, pages 24 – 32.*

Specifically, with respect to the mischaracterizations of Schumacher, “reference[s] may be relied upon for all that it would have *reasonably suggested* to one having ordinary skill the art...” *MPEP §2123*. However, none of the elements cited by the Examiner as present in Schumacher as a basis for rejecting the current claims would have reasonably suggested

themselves as being equivalent to the elements of Applicant's claims. Examples include (but are not limited to):

1. the claimed specimen pan or container for holding fetal remains rejected based on the scoop, cardboard box, or a bottle (prefilled with sodium hypochlorite) of Schumacher. Not only would none of the Examiner's purported fetal receptacles suggest themselves to one skilled in the art for use as such (while the Examiner apparently feels that grieving mothers would be ok with shoving their just passed fetuses into a bottle past the small neck as disclosed by Schumacher, mutilating their tiny bodies in the process, or putting it in a cardboard scoop or box, one skilled in the art would certainly not.), those structures are incapable of serving that purpose. See Appeal Brief, page 29 – 30.

2. the claimed "underpad/bed liner", "sanitary napkin," and "absorbent towel," rejected based on a towel of Schumacher (preferably of the disposable paper variety). One skilled in the art would appreciate the difference between a paper towel, a sanitary napkin, and an underpad/bed liner. Again, a towel not only does not suggest itself as a bed liner nor a sanitary napkin, but it is incapable of serving this purpose. See Appeal Brief, page 31.

Nor does Friedbauer the disclosure deficiencies of Schumacher, as Friedbauer fails to disclose a sanitary napkin, a towel, a specimen pan for receiving human tissue, and a container for holding fetal remains for legal disposition as recited in independent claim 1, 35 and 38.

Because claims 25-31, 35-37 and 40 depend from claim 1, they are allowable for at least the same reasons, and further in view of their additional recitations. Reconsideration and allowance are requested.

Claims 35 - 37 are not obvious in view of Schumacher and Gordon

The arguments of Applicant's Appeal Brief with respect to Gordon and Schumacher combined with Gordon are incorporated herein by reference in their entirety. See Appeal Brief, at least pages 33-35.

First, the Gordon specimen pan cannot serve as the specimen pan of independent claim 35 at least because the Gordon pan is not "positioned and sized to receive fluids and waste from a miscarriage," as recited in claim 35. The pan of Gordon is designed to collect stool samples from the anus, and not a fetus from the vagina. See Appeal Brief, page 33-34.

Second, the Examiner does not propose a rationale for how a collapsible cardboard box of the primary reference (Schumacher) could be modified based on the teachings of Gordon to

collect the fetus in the disclosed way and still function to both contain the rest of the kit contents (for disposal or storage) or scoop up waste off the floor in a sanitary fashion as taught by Schumacher. The combination of Schumacher and Gordon is improper as it would render Schumacher unsatisfactory for its intended purpose. *MPEP §2143.01(V)*. See Appeal Brief, page 34 – 35.

Claims 36 and 37 depend from claim 35 and are thus patentable for at least the same reasons and further in light of their additional recitations. Reconsideration and allowance are thus respectfully submitted.

Claims 38 – 42 are not obvious in view of Schumacher, Friedbauer and Gallo (6,622,856)

The Examiner states that “it would be obvious ... to provide the kit of Schumacher with a thermometer, as taught by Gallo, for the monitoring of temperature.” *Office Action*, page 8. Gallo does not remedy the disclosure deficiencies of Schumacher. There is nothing disclosed, taught, or suggested in Gallo that could be equated with an underpad/bed liner, a sanitary napkin, a specimen pan for receiving human tissue, or a container for holding fetal remains for legal disposition. Moreover it would not be obvious to modify the Schumacher, one-time human waste cleanup kit to include a thermometer. There is *NO MOTIVATION* to include a thermometer as nothing in or collected by any of Schumacher or Gallow requires taking a temperature. See Appeal Brief, page 35 – 36.

Conclusion

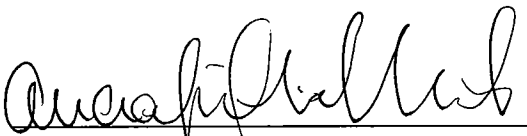
For at least the above reasons, claims 1, 25 – 31, 35 – 42 are allowable. Applicants respectfully request that an appointed panel of examiners review the current case. Applicant further requests that the panel allow the application or propose amendments.

Respectfully submitted,

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